



503.39984X00/P5945/RH

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Tadashi FUJIEDA *et al.*
Serial No. : 09/828,150
Filed : 9 April 2001
For : ELECTROMAGNETIC WAVE ABSORBER,
METHOD OF MANUFACTURING THE
SAME, AND APPLIANCE USING THE SAME
Art Unit : 2636
Examiner : B. Swarthout
Conf. No. : 6547

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[Signature]
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Technology Center 2600

RESPONSE

Commissioner for Patents
P08 1450
Alexandria, Virginia 22313-1450

8 December 2003

Sir:

In response to the Office Action mailed 8 October 2003 in connection with
the above-identified application, the following is respectfully submitted.

PENDING CLAIMS

Claims 1-37 were pending in the application at the time of the Office Action.
At entry of this paper, Claims 1-37 remain pending in the application for further
consideration and examination.

RESTRICTION/ELECTION REQUIREMENT - TRAVERSED

A restriction/election requirement has been made for the reasons beginning
on page 2 of the Office Action. Applicant respectfully traverses based upon the
following ground(s).

NOT INDEPENDENT AND DISTINCT INVENTIONS

As traversal, Applicant notes that 35 USC §121, the basis for a restriction and election of species requirement, provides for a restriction only if two or more independent and distinct inventions are claimed in one application. While §802.01 of the Manual of Patent Examining Procedure indicates that restriction and/or election of species may be permissible between independent or distinct inventions, such section of the Manual of Patent Examining Procedure is clearly erroneous in view of the plain and unambiguous language of 35 USC §121.

In this connection, the above-noted section of the Manual of Patent Examining Procedure defines the term "independent" as meaning there is no disclosed relationship between the two or more subjects disclosed that is, they are unconnected in design, operation or effect. It is respectfully submitted that a contention cannot validly be made that the subject matter recited in the claims in issue relating to the respective embodiments of the present invention have no disclosed relationship, for if such is the case, such contentions are clearly without merit as a review of the instant specification and the claimed subject matter reveals. More particularly, to show that Applicant's claims are related, Applicant respectfully submits the following comments.

As one example, the alleged Group II, Claims 13-20 have substantial "ceramic" features/limitations overlapping with "ceramic" features/limitations of the alleged Group I, Claims 1-12. Any search/examination of such groups would be substantially (if not completely) overlapping. Accordingly, at minimum, all of Group I and II's Claims 1-20 should be searched/examined together.

With further regard to the erroneous restriction/election position presented in the Manual of Patent Examining Procedure (*i.e.*, teaching restriction/election for "independent or distinct inventions", instead of the unambiguous "independent and distinct inventions" statutory language), as pointed out by Mr. McKelvey in the concurring opinion in Ex parte Hartmann, 186 USPQ 366 (Bd. App. 1974), relying upon the Decision of Ex parte Schwarze, 151 USPQ 426 (Bd. App. 1966) the Manual of Patent Examining Procedure merely provides guidelines for Examiners in the Patent Office and it does not replace, and is subservient to, applicable statutes, Rules of Practice, and prior decisions. Thus, it would appear that by virtue of the plain and unambiguous language of 35 USC §121, the statute only permits an election of species requirement between two or more independent and distinct inventions (not independent or distinct inventions) in spite of the circumlocutory argumentation of §802.01 of the Manual of Patent Examining Procedure.

Furthermore, in view of the interrelationship of the inventions designated in the Office Action, and in view of the fact that each of the designated inventions are, in essence, based upon the same basic inventive concept, Applicant respectfully submits that the designated inventions are not independent and distinct to the extent required by 35 USC §121 to support a restriction requirement. In this connection, Applicant notes that a basic inventive concept of the claims in issue relates to wave absorbers and/or composite members, and the use of such components in various embodiments, *e.g.*, devices, communications, toll gate set-ups, etc. Especially the Group I and II Claims 1-20 have substantial "ceramic" features/limitations overlapping with "ceramic" features/limitations. Applicant respectfully submits that

these differences should not be considered as rendering the respective embodiments independent and distinct to the extent required by 35 USC §121.

In summary, the Office Action has failed to clearly convince how the subject matter recited in the respective groups of claims represents both independent and distinct inventions are required by 35 USC §121.

RELATED INVENTIONS - NO SERIOUS BURDEN FOR EXAMINATION

As traversal, presuming *arguendo* that one could establish that the subject matter recited in the claims in issue relating to the respective embodiments of the present invention relate to independent and distinct inventions as required by 35 USC §121, as pointed out in §803 of the Manual of Patent Examining Procedure, if a search and an examination of an entire application can be made without serious burden, the Examiner must examine the entire application on the merits even though the application includes claims to distinct or independent inventions. In view of the fact that all claims are related as described previously above, and given the fact, for example, that the alleged Groups I and II claims contain similar, analogous and/or overlapping limitations, it is respectfully submitted that search and examination of an entirety of the claims in the instant application would not create a serious burden on the part of the United States Patent and Trademark Office. Accordingly, since the Examiner must examine the entire application, the Restriction/Election should be withdrawn.

PROVISIONAL ELECTION

In order to comply with the election of species requirement, Applicant provisionally elects, with traverse, for prosecution on the merits, Group I, including at least Claims 1-12.

NO ADMISSION - RESTRICTION/ELECTION

Applicant submits that the instant response (including the comments submitted and the provisional election) is not an admission on the record that the respective species are separately distinct species and/or obvious variants.

CONTINUATION(S)/DIVISIONAL(S) FOR NON-ELECTED SUBJECT MATTER

Despite any traversal set forth in other parts of this paper regarding any Restriction/Election, one or more related (*e.g.*, continuation/divisional) applications may be filed to pursue subject matter not elected in the present application. Applicant submits that any filing of continuation(s)/divisional(s) should not be taken as any prejudice, admission or disclaimer that the Restriction/Election is correct, but instead, is merely use of separate applications to move the other subject matter through the patenting process.

CONTINUATION(S)/DIVISIONAL(S) - DOUBLE PATENTING PROHIBITED

Regarding any related continuation/divisional application(s) filed to pursue subject matter identical to or consonant with Restriction/Election subject matter not elected in the present application, it is respectfully submitted that the third sentence

of 35 U.S.C. §121 and MPEP §804.01 prohibit any double-patenting rejection between this and any related continuation/divisional applications.

RESERVATION OF RIGHTS

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

EXAMINER INVITED TO TELEPHONE


The Examiner is invited to telephone the undersigned at the local D.C. area number 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that the claims listed above as presently being under consideration in the application are in condition for allowance. Accordingly, early allowance of such claims is respectfully requested.

Attached hereto is a Petition for Extension of Time Under 37 CFR §1.136 and Form PTO-2038 authorizing payment of the requisite Petition fee (Code 1251). To whatever other extent is actually appropriate and necessary, Applicant respectfully petitions the Commissioner for an extension of time under 37 CFR §1.136. Please charge any shortage in fees to ATS&K Deposit Account No. 01-2135 (referencing Case No. 503.39984X00).

Respectfully submitted,



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ATTACHMENTS:

Petition for Extension of Time
Form PTO-2038 (Fee Code 1251)